



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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5-17-96
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In Re Appln. of: Robert Filepp et al.

Group Art Unit: 2307

Serial No.: 08/158,029

Examiner: Wayne Amsbury

Filed: November 26, 1993

Title: METHOD FOR LOCATING APPLICATION RECORDS
IN AN INTERACTIVE-SERVICE DATABASE

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REPLY BRIEF

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

Applicants, by certificate of mailing dated January 19, 1996, submitted their brief in support of an appeal initiated by notice dated July 19, 1995, the Appeal being taken from a decision of the Examiner dated January 19, 1995, which finally rejected Applicants' pending Claims 1-15. Subsequently, Applicants received an answer to their Appeal Brief from the Examiner dated March 28, 1996. The Examiner's Answer, however, not only failed to support the final rejection, but also raised a number of new points of argument which have required Applicants to submit this brief in reply. Accordingly, in view of arguments presented in their Appeal Brief, and this Reply Brief which demonstrate the impropriety of the final rejection and the patentability of their invention, and the absence of justification for the final rejection in the Examiner's Answer, Applicants request that the Board Of Patent Appeals and Interferences order the final rejection of January 19th 1995 be withdrawn; that Applicants be permitted to amend their claims 1-15 as proposed; and that their claims be allowed and their application passed to issue.

PREFACE

In response to Applicants' Appeal Brief, the Examiner has submitted an Answer in which he has declined to address the points of law and presentations of fact submitted by Applicants. Rather than attempt to rebut the arguments advanced by Applicants which demonstrate the impropriety of the final rejection and which support patentability of the pending claims, the Examiner's in his Answer has merely restated the final rejection and offered scant and incomplete reference to minimal portions of the Applicants' Appeal Brief. Accordingly, the Examiner must be considered to have conceded the Applicants' arguments which he has declined to address. However, in the minimal response the Examiner has offered, he has raised a number new points of argument and created confusion with respect to others all of which have been identified below and which Applicants wish to reply to.

REPLY

I. ENTRY OF AMENDMENT IMPROPERLY DENIED

A. The Amendment Submitted:

As a first new point of argument, the Examiner noted in his Answer that the amendment Applicants submitted with their Appeal Brief to put the claims in better form for appeal was not entered (Answer at pg. 1, lns. 15-19; pg. 12, lns. 2-4). Further, the Examiner stated that since he did not enter the amendment, "portions of Applicants' Arguments" were mooted and not responded to (Answer at pg. 12, lns. 2-4).

The Examiner's contention that Applicants' amendment to place the claims in better form for appeal should be denied entry is not only improper, but also, takes Applicants by surprise. Yet further, despite the fact that the Examiner noted in his Answer that Applicants' amendment was not entered, the Examiner, in his advisory action issued February 28, 1996, directed to the amendment, expressly stated that

Applicants' response had overcome the Examiner's prior "[r]ejection of claims {6-10} under 35 USC 112.2d in regard to a record as an 'interactive application'" and "the rejection of claims {11-15} in regard to ']' in claim 11", thus removing those rejections from this Appeal (Advisory Action at pg. 1).

In the amendment submitted with their Appeal Brief, Applicant proposed to simply amend four claims to put them in better form for appeal. Specifically, Applicants proposed claim amendments to correct typographical error and provide editorial simplification. Specifically, in Claim 6, Applicants proposed to change the claim wording to note that the records to be searched in accord with Applicants' method were objects used in generating interactive applications.

Specifically, Applicants proposed Claim 6 be amended as follows:

6. (Twice Amended) The method of claim 5 wherein the records to be searched for and retrieved are objects used in generating interactive applications associated with an interactive service[, and wherein the applications are arranged to be generated from objects].

As is plain from the proposed amendment, no change in scope or meaning of the claim was intended or sought, and no new issues or need for search were presented.

As a second amendment, Applicants proposed to change Claim 11 by adding an "s" to the word "system" in the preamble to correct a typographical omission and provide correct number agreement. Additionally, Applicants proposed to eliminate a "]" improperly entered in part "f" of the claim when it was first amended and add the word "and" at the end of part d to provide a transition between parts "d" and "e."

Specifically, Applicants proposed the following:

11. (Twice Amended) A method of searching for and retrieving applications included as records in an interactive service database stored in a computer network, the network having a plurality of reception systems at which respective users can request and retrieve applications, and the applications being made up of objects collectively containing presentation data and program instructions, the method comprising the steps of:

a. preparing a plurality of tables, each table including keywords respectively referenced to application identifiers so that each establishes a predetermined subset search of the applications stored in the service database;

- b. providing each table with a unique code designation;
c. generating a table code designation in response to a query entered at the reception system for an application;
d. comparing the table code designation generated with the available table code designation to select a table suited to the query; and
e. providing the table at the reception system at which the query was entered so that the requested application may be identified from the table and so that the application may be retrieved at the reception system where the query was entered[]; and
f. Processing the table identified applications at the reception system where the query was entered[].

As is again plain, no change in claim scope was intended or sought, and no new issues or need for search were presented.

Still further, Applicants proposed to amend Claim 13 to correct yet other typographical errors. Specifically, Applicants proposed to change the word "identifiers" following the words "table code" to the word "designations" to conform description of the table codes to the description in the claims from which Claim 13 depends. Additionally, Applicants proposed to change the word "applications" to "an application" to provide proper number agreement, and addition of the word "each" to more clearly describe the table code designations.

Specifically, Applicants proposed Claim 13 be amended as follows:

13. (Twice Amended) The method of claim 12 wherein generating the table code [identifiers] designations includes receiving a query for [applications] an application produced using one of a plurality of different procedures and translating the query produced using one of the different procedures into a single procedure common to all procedures for generating the table code designations, the table code designations each including one or more letters in combination to uniquely identify a table.

Here again, it is obvious the sole intention was to correct typographical errors and provide grammatical correctness. No new issues were presented and no need for additional searching arose.

Finally, Applicants proposed to amend Claim 15 to simplify claim wording and to remove the Examiner's antecedent objection to the terms "text and graphic data."

Specifically, the Applicants proposed that Claim 15 be amended to read as follows:

15. (Twice Amended) The method of claim 14 wherein the processing of table identified applications includes collecting at the reception system the objects which make up [the] an application [that are] derived by using [the] an identified table, and executing the objects so as to present the [corresponding text and graphic data for review] the application at the reception system.

Once again, no change to claim scope was intended or sought, and no new issues or need for new searching was presented.

B. The Examiner's Response to the Proposed Amendment

The Examiner's response to the proposed amendment, was to refuse its entry. Without any explanation, the Examiner simply asserted that "[t]he scope of claims 6-11 is changed by the amendment."

The Examiner's contention is plainly without foundation both as a matter of fact and as a matter of law. He has neither made any factual showing to demonstrate a change in claims scope nor offered any analysis which would support an interpretation of the claims as amended having a meaning substantially different from the meaning of the claims before amendment. By the clear wording of the proposed amendments, the scope of the claims proposed to be amended was not changed. Rather, the intended purpose and plain effect of the amendments were to provide changes to form only. And, by the express wording of 37 CFR 1.116, Applicants should be permitted to amend their claims to put them in better form for appeal. That was all that Applicants' proposed amendment did. The changes were addressed solely to correction of typographical errors and the providing of editorial simplification.

The Examiner's refusal to enter the amendments is arbitrary and an abuse of discretion. Accordingly, Applicants have submitted together with this Reply a Petition to the Commission requesting that the Examiner be compelled to enter the amendment as filed.

**C. The Examiner Removes Rejections to Claims 6-11
Under 35 USC §112, 2nd Paragraph**

Continuing, and as noted above, the Examiner, however, in the Advisory Action forwarded to Applicants responsive to the proposed amendment, expressly noted that Applicants' submission had overcome the Examiner's former "[r]ejection of claims {6-10} under 35 USC 112.2d in regard to a record as an 'interactive application'" and "the rejection of claims {11-15} in regard to 'J' in claim 11", thus removing those rejections from this Appeal (Advisory Action at pg. 1).

The effect of Examiner's determination that Applicants' submission had overcome the Examiner's former rejection of Claims 6-10 and 11 was not only to remove those rejections from the Appeal, but also, to render unnecessary the amendment of Claim 6 and Claim 11 described above. In proposing to amend Claims 6 and 11, Applicants were attempting to provide a form for the noted claims which would traverse the very rejections the Examiner subsequently withdrew. Accordingly, by removing the noted rejections, the Examiner's action has had the consequence of rendering the proposed amendment to Claims 6 and 11 moot.

Still further, the Examiner's removal of the noted rejections has had the additional effect of conceding Applicants points of argument I., B., Point 2 and Point 3 presented at pgs. 18-20 and pgs. 20-21 of the Appeal Brief.

And, yet additionally, the Examiner's removal of the noted rejections has had the further effect of establishing Claims 11 and 12 as in accord the requirements of 35 USC §112, 2nd paragraph - by the Examiner's express admission, no other rejection of Claims 11 and 12 under 35 USC §112, 2nd paragraph has been made.

However, as also noted in the Advisory Action, the Examiner stated that the "other 112.2d rejection(s) of claims 1-15" were to remain. As asserted in the Final Rejection the "other" rejections the Examiner asserted under 35 USC §112, 2nd paragraph included:

- Rejection of Claims 1-10 on the grounds that part "d" of Claim 1 was allegedly "confusing" (Final Rejection at pgs. 2-3);

- Rejection of Claims 13-15 on the grounds that the phrase "the table code identifiers" in Claim 13 lacked an antecedent, (Final Rejection at pg. 4); and

- Rejection of Claim 15 on the grounds that the phrase "the corresponding text and graphic data" lacked an antecedent and that the plural form of the word "objects" was unclear (Final Rejection at pgs. 4-5).

With regard to the Examiner's continuing rejection of Claims 1-10 under 35 USC §112, 2nd paragraph, the Examiner has based the rejection of Claims 1-10 solely on his mistaken interpretation of Claim 1, particularly, part "d" thereof. Applicants demonstrated in their Appeal Brief that this rejection was improper both as a matter of law and as a matter of fact. At Section I., A, of their Appeal Brief, Applicants pointed out that in accord with now venerable patent law principles, which the Examiner has in no way disputed, claims fully satisfy the requirements of 35 USC §112, 2nd paragraph where the claims, when read in light of the specification, reasonably apprise those skilled in the art of their scope. *Miles Laboratories Inc. v. Shandon Inc.*, 997 F.2d 870, 27 USPQ2d 1123, (Fed. Cir. 1993). Additionally as further shown at Section I., B., Part 1 of their Appeal Brief, and as will be amplified below, Applicants Claim 1, and especially part "d", is eminently clear when read in light of the specification. The Examiner's inability to understand the Claim plainly arises for his refusal to refer to the specification for the meaning of the express limitations included in the Claim wording (Appeal Brief at pgs. 13-18). This is incorrect as a matter of law. The Examiner's rejection of Claim 1-10 under 35 USC §112, 2nd paragraph must be reversed.

Regarding the Examiner's rejection of Claims 13-15 under 35 USC §112, 2nd paragraph, despite the Examiner's improper and unjustified refusal to admit the above described amendment which was designed and submitted to moot the questions raised by the Examiner, Applicants' Claim 13 and Claims 14, 15 which depend from it are not indefinite even if unamended. The Examiner contends Claim 13 and with it Claims 14-15, are indefinite because in the Examiner's opinion the phrase "the table code identifiers" in Claim 13 lacked an antecedent.

The Patent and Trademark Office Board of Patent Appeals and Interferences, however, has repeatedly held that the question of whether a claim is rendered defective under 35 USC §112, 2nd paragraph for alleged lack of an antecedent for one of its claim term depends, as always, on whether one skilled in the art would understand the claim when read in the light of the specification and the other claims of the application. *Ex parte Porter*, 25 USPQ2d 1144, 1446, (BdPatApp&Int, 1992). As is plain on review of Applicants' Claims 11 and 12 from which Claim 13 depends, the word "identifiers" in the objected to phrase "table code identifiers" was clearly a typographical error. The word "identifiers" was mistakenly included where the word "designations" was intended. Reference to Claims 11 and 12 show that the proper and intended reference to the table codes is "table code designations." This would be immediately apparent to anyone skilled in the art. Accordingly, under the test for claim definiteness above noted, and the other authority cited in Applicants' Appeal Brief which the Examiner has not disputed, Claim 13 as well as Claims 14, 15 are within the requirements 35 USC §112, 2nd paragraph. Still further, the Examiner has offered no authority for the proposition which he attempts to impose here, namely, that an obvious, singly-occurring typographical error is alone sufficient to render a claim improper under 35 USC §112, 2nd paragraph.

The Examiner's rejection is plainly in error and must be reversed or at least restated as an objection subject to remedial amendment.

Regarding the Examiner's rejection of Claim 15 under 35 USC §112, 2nd paragraph, again, despite the Examiner's improper and unjustified refusal to admit the above described amendment which was submitted to moot the questions raised by the Examiner, Applicants' Claim 15 is not indefinite even if the proposed amendment is not entered.

Here again, the Examiner contends that a claim is rendered unacceptable because of the absence of an antecedent for a recited claim term. However, once again, the Examiner has attempted to view the Claim in a Vacuum. As noted, The Patent and Trademark Office Board Of Patent Appeals and Interferences has established that for purposes of evaluation under 35 USC §112, 2nd paragraph, a claim is to be reviewed

in light of the specification and other claims *Ex parte Porter, Id.* Additionally the Board of Patent Appeals and Interferences has also established that an antecedent is not required where the accused term is "implicit" in the matter covered by the claim. *Ex parte Harvey*, 3 USPQ2d 1626, 1628 (BdPatApp&Int, 1987).

As is would be immediately clear to anyone skilled in the art which Applicants' claims concern, either on reference to Applicants specification, Applicants claims or the art generally, text and graphic data are inherent in the interactive applications to be searched for and displayed. No ambiguity exists. The Examiner's rejection of Claim 15 under 35 USC §112, 2nd paragraph is in error as a matter of fact and law and must be reversed or at least restated as an objection subject to remedial amendment.

II. APPLICANTS CLAIMS 1-10 DEFINITE UNDER 35 USE §112, 2ND PARAGRAPH

A. Claim 1 Definite under 35 Use §112, 2nd Paragraph

As a further new point of argument, the Examiner contended in his Answer that the interpretation Applicants presented in their Appeal Brief regarding Claim 1 was not based on limitations that are specified in Applicants' Claims 1-10 (Answer at pg. 12, lns. 10-19).

By simple reference to Applicants' Claim 1 and Applicants' Appeal Brief at Section I., B., Part 1, the Examiner's assertion are found wholly without foundation and in clear error.

In finally rejection Claims 1-10 under 35 USC §112, 2nd paragraph, the Examiner asserted that part "d" of Claim 1 was confusing. As contended by the Examiner, part "d" of Claim 1 multiple interpretations.

However, as demonstrated in Applicants' Appeal Brief, the express wording of part "d" of Claim 1, when read in light of the specification, not only showed that no ambiguity as to the features of Claim 1 existed, but additionally, that the contrived interpretation the Examiner sought to be impose in order to justify the rejection was plainly in error and could only have resulted from a complete failure to consult the specification (Appeal Brief at pgs. 15-18).

More particularly, part "d" of Claims 1 expressly states Applicants' method includes steps for:

- generating a locator group code designation in response to a request for a record,
- so that a group of record locators may be provided at the reception system and
- so that a locator may be selected which enables identification and retrieval of the record.

And, from a reading of Applicants' specification, it is clear that what part "d" of Claim 1 concerns are the procedures described in Applicants' specification at pg. 30, ln. 17 - pg. 31, ln. 4. Specifically, the steps of Applicants' method by which the system generates a character string at the reception system in response to the entry of an application request by the user with, for example, the JUMP, INDEX or DIRECTORY procedure; and the subsequent steps by which that character string is, thereafter, compared to the sequence set to provide a keyword-object-identifier table at the reception system from which the system can generate a keyword and associated identifier for the page template object of the application requested; and the steps which in turn lead to presentation of the requested application.

As described in the specification:

In the preferred embodiment, the network includes procedures for creating preliminary searches which represent subsets of the network applications users are believed likely to investigate. Particularly, in accordance with these procedures, for the active applications available on network 10, a library of tables [Library of GROUPS] is prepared, and maintained within each of which [GROUP] a plurality of so called "keywords" [LOCATORS] are provided that are correlated with page template objects and object-ids [IDENTIFIERS] of the entry screen (typically the first screen) for the respective application. In the preferred embodiment, approximately 1,000 tables are used, each having approximately 10 to 20 keywords arranged in alphabetical order to abstract the applications on the network. Further, the object-id for each table is associated with a code in the form of a character string mnemonic which is arranged in a set of alphabetically sequenced mnemonics termed the sequence set so that on entry of a character string at an RS 400, the object-id for the relevant keyword table can be obtained from the sequence set. Once the table object-id is identified, the keyword table corresponding to the desired subset of the objects and associated applications can then be obtained from network 10. Subsequently the table can be presented to the user's RS 400, where the RS 400 can provide the data processing required to present the potentially relevant keywords, objects and associated applications to the user for further review and determination as to whether more searching is required. (Emphasis added)

Specification at pg. 30, ln. 17 - pg. 31, ln. 4.

According, when Claim 1 is read in light of Applicants' specification, that is where the express limitation contained in the Claim are given the meaning ascribed to the wording as found in the specification, the Claim is seen to be eminently clear and not subject to the misunderstanding sought to be ascribed to the Claim by the Examiner.

The Examiner problem with understanding Claims 1-10 arise solely from his refusal to consult the specification. As noted in Applicants' Appeal Brief this is clearly contrary to the established law regarding the requirements to be met under 35 USC §112, 2nd paragraph.

The Examiner's rejection of Claim 1 and Claims 2-10 which depend from it on the grounds asserted is clearly in error as a matter of law and must be reversed.

B. Claim 5 Definite under 35 Use §112, 2nd Paragraph

As a further new point of argument, the Examiner in his Answer asserts for the first time that Applicants' Claim 5 was rejected under 35 USC §112, 2nd paragraph on grounds related to records as interactive applications (Answer at pg. 13, lns. 1-14).

Review of the Final Rejection shows, however, that Claim 5 was never rejected under 35 USC §112, 2nd paragraph in regard to records as interactive applications. Indeed, the only ground the Examiner asserted against Claim 5 under 35 USC §112, 2nd paragraph was indefiniteness by virtue of dependency from Claim 1 and the alleged "confusion" concerning part "d" of Claim 1. Moreover, Claim 5 makes absolutely no express reference to interactive applications.

Still further, the reference in Applicants' Claims to interactive applications arises in Claims 6. And, as prominently noted in the Advisory Action and as discussed above, the Examiner expressly removed the rejection of Claims 6-10 under 35 USC §112, 2nd paragraph in regard to records as interactive applications, thus removing those issues from this Appeal (Advisory Action at pg. 1).

Therefore, for the reasons noted in connection with Claim 1 both above and in the Appeal Brief, and the Examiners express withdrawal of the issues concerning

records and interactive applications from this Appeal, as well as Applicants' arguments presented in Section I., B., Part 2, of the Appeal Brief, Claim 5 is not improper under 35 USC §112, 2nd paragraph. Accordingly, any rejection of Claim 5 under 35 USC §112, 2nd paragraph is in error and must be reversed.

III. APPLICANTS' CLAIMS PATENTABLY DISTINGUISHED OVER THE CITED ART:

A. Applicants' Claimed Invention Fundamentally Different

As a still further new point of argument, the Examiner in his Answer contends that Applicants' distinction of their claimed invention from the cited art as presented in Applicants' Appeal Brief is not based on limitations found in Applicants' claims, but rather, based on limitations found in Applicants specification. As a result, the Examiner further contends Applicants showing is not sufficient to overcome the final rejection of Applicants Claims 1-15 under 35 USC §102(b) as anticipated in view of U.S. patent 4,429,385 issued to Cichelli et al. (Cichelli et al.) (Answer at pg. 13, ln. 16 - pg. 14, ln. 3).

As a first point is must be noted that the Examiner has offered absolutely no opposition to the test for establishing anticipation under 35 USC §102(b) cited in Applicants' Appeal Brief. Accordingly, the Examiner must be considered to have acknowledged that in order for anticipation to be found, each and element of the claimed invention must be literally present in the alleged anticipating reference, and, that those elements must be arranged in the alleged anticipating reference in the same fashion that they are arranged in the claimed invention. *Richardson v. Suzuki Motor Co. Ltd.*, 869 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Still further, it is also instructive to note that while the Examiner contends that the limitations which distinguish Applicants' invention from the cited reference are found in Applicants' specification, he, at least, has acknowledged that Applicants' invention is distinguished from and not anticipated by the cited reference.

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However, more important that the Examiner's concessions are the factual reality of the distinctions between Applicants' invention as claimed and the cited reference.

As demonstrated in Applicants' Appeal Brief, the teaching of the cited Cichelli et al. patent is fundamentally and markedly different from Applicants' invention both as it is taught in Applicants' specification and as it expressly described in Applicants' claims (Appeal Brief, Section II., B., 1-2, pgs. 24-46).

The cited reference concerns a sequential database in a non-interactive, Teletext system. The database records are arranged in a serial, fixed order and can only be accessed by physically moving from one record to next. Potentially the entire database must be streamed passed the record selection means in order to pick out a desired record. Further, to search for particular records, the user can only manually progress through a fixed series of hierarchical menu screens in order to identify the record desired. Then and only then is a record identification number generated which is used to thereafter flag the desired record from the streaming sequential data base.

The approach and operation of the cited reference is fundamentally and completely different for the Applicants' invention. In accord with Applicants' invention, a direct access database is used, that is, a database in which any record can be randomly accessed with a record identification number.

Further, to enable search of Applicants' database, Applicants teach use of predetermined, subset search of the random database in which groups of record locators in the form of key words are, respectively, fixed indexed to record identifiers.

Yet further, and fundamentally different from the cited reference, the predetermined subset set searches are provided with code designations that permit any group of indexed locators and identifiers to be randomly selected by generating a code designation in response to entry of a request for a record by the user.

As described in Applicants specification and as noted above, In the preferred embodiment, the network includes procedures for creating preliminary searches which represent subsets of the network applications users are believed likely to investigate. Particularly, in accordance with these procedures, for the active applications available on network 10, a library of tables [Library of GROUPS] is prepared, and maintained within each of which [GROUP] a plurality of so called

"keywords" [LOCATORS] are provided that are correlated with page template objects and object-ids [IDENTIFIERS] of the entry screen (typically the first screen) for the respective application. In the preferred embodiment, approximately 1,000 tables are used, each having approximately 10 to 20 keywords arranged in alphabetical order to abstract the applications on the network. Further, the object-id for each table is associated with a code in the form of a character string mnemonic which is arranged in a set of alphabetically sequenced mnemonics termed the sequence set so that on entry of a character string at an RS 400, the object-id for the relevant keyword table can be obtained from the sequence set. Once the table object-id is identified, the keyword table corresponding to the desired subset of the objects and associated applications can then be obtained from network 10. Subsequently the table can be presented to the user's RS 400, where the RS 400 can provide the data processing required to present the potentially relevant keywords, objects and associated applications to the user for further review and determination as to whether more searching is required.

(Specification at pg. 30, ln. 17 *et seq.*)

These features are nowhere to be found or suggested in the cited reference.

B. Applicants' Claims Expressly Recite Limitations Neither Shown Nor Disclosed in the Cited Reference

As noted, the cited reference neither suggests nor discloses the method features and elements of Applicants described system, and those same method features and elements have been expressly included as specific limitation in varying degrees in Applicants' Claims 1-15.

Specifically, Applicants Claim 1 expressly recites:

1. A method of searching for and retrieving records included in a database provided in a computer network, the network having a plurality of reception systems at which respective users can request and retrieve respective records, the method comprising the steps of:
 - a. providing record locators indexed to record identifiers for the respective database;
 - b. arranging multiple locators and respective indexed identifiers in a plurality of groups, the groups respectively establishing predetermined subset searches of the database records;
 - c. assigning code designations to the respective locator groups;

d. generating a locator group code designation in response to a request for a record so that a group of record locators may be provided at the reception system and so that a locator may be selected which enables identification and retrieval of the record.

As described above and in Applicants Appeal Brief, the cited reference neither suggests nor discloses:

- providing record locators indexed to record identifiers for the respective database; or
- arranging multiple locators and respective indexed identifiers in a plurality of groups, the groups respectively establishing predetermined subset searches of the database records; or
- assigning code designations to the respective locator groups; or
- generating a locator group code designation in response to a request for a record so that a group of record locators may be provided at the reception system and so that a locator may be selected which enables identification and retrieval of the record.

Applicants' Claim 1 is not anticipated by the cited reference. The Examiner rejection of Claim 1 under §102(b) is in error and must be reversed. *Richardson v. Suzuki Motor Co. Ltd.*, 869 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989).

Continuing, Applicants Claim 2 expressly recites:

2. The method of claim 1 wherein providing record locators indexed to record identifiers includes setting the locators as mnemonics that are indexed to the respective identifiers for the respective records in the database.

As described above and in Applicants Appeal Brief, the cited reference neither suggests nor discloses

- setting the locators as mnemonics that are indexed to the respective identifiers for the respective records in the database.

With regard to the Examiner's comment that no table structure is recited in Claim 2, Applicants would point out that none need be. As noted in the cited authority, which as stated, the Examiner has neither opposed nor challenged, a cited reference, can not anticipate a claimed invention if the cited reference lacks elements included in the invention as expressly claimed. A plain reading of Cichelli et al. shows no tables of any kind are contemplated. At best, Cichelli et al. propose use of manually manipulated display screens that lack keyword locators indexed to record identifiers. Applicants' Claim 2 is not anticipated by the cited reference. The Examiner rejection of Claim 2 under §102(b) is in error and must be reversed. *Richardson Id.*

As to Applicants Claim 3, it expressly recites:

3. The method of claim 2 wherein arranging the locators in groups includes arranging the locator mnemonics in tables in which the respective mnemonics are indexed to the respective record identifiers.

As described above and in Applicants Appeal Brief, the cited reference neither suggests nor discloses:

- arranging the locator mnemonics in tables in which the respective mnemonics are indexed to the respective record identifiers.

Applicants' Claim 3 is not anticipated by the cited reference. The Examiner rejection of Claim 3 under §102(b) is in error and must be reversed. *Richardson Id.*

As to Claim 4, Claim 4 expressly recites:

4. The method of claim 3 wherein assigning code designations to the respective locator groups includes establishing the respective code designations as alphabetically sequenced character strings such that when a character sequence is entered at a reception system to designate a requested record, a locator table may be provided at the reception system from which a group of respective record identifiers may be selected.

As described above and in Applicants Appeal Brief, the cited reference neither suggests nor discloses:

- establishing the respective code designations as alphabetically sequenced character strings such that when

a character sequence is entered at a reception system to designate a requested record, a locator table may be provided at the reception system from which a group of respective record identifiers may be selected.

Once again the Examiner's meager comments presented in his Answer fail to embrace the requirements of the law regarding anticipation. Not only does Cichelli et al. fail to disclose or suggest the use of tables, but, indeed Cichelli et al. fail to suggest or disclose entry of a character at the reception system so that a table may be provided at the reception system from which a record identified may be selected. The Cichelli et al. teach does not embrace Applicants' claimed invention. Applicants' Claim 4 is not anticipated by Cichelli et al. The Examiner rejection of Claim 4 under §102(b) is in error and must be reversed. *Richardson Id.*

Continuing, Applicants Claim 5 expressly recites:

5. The method of claim 4 wherein providing record locators indexed to respective record identifiers includes establishing the locators as keywords and wherein the character sequence entered at the reception system to designate a requested record may be entered using a plurality of search procedures.

As described above and in Applicants Appeal Brief, the cited reference neither suggests nor discloses:

- establishing the locators as keywords and wherein the character sequence entered at the reception system to designate a requested record may be entered using a plurality of search procedures.

Applicants' Claim 5 is not anticipated by the cited reference. The Examiner rejection of Claim 5 under §102(b) is in error and must be reversed. *Richardson Id.*

Applicants' Claim 6 expressly recites:

6. The method of claim 5 wherein the records to be searched for and retrieved are interactive applications associated with an interactive service, and wherein the applications are arranged to be generated from objects.

As described above and in Applicants Appeal Brief, the cited reference neither suggests nor discloses:

- the records to be searched for and retrieved being interactive applications associated with an interactive service, and
- wherein the applications are arranged to be generated from objects.

As explained in Applicants' Appeal Brief at pgs. 19-20, the records to be search for are objects which, as fully described in Applicants specification at pg. 29, lns. 16-29; pg. 20, lns. 16-23 and expressly recited in Claim 6, are used to generate interactive application. The Cichelli et al. teaching has no relation at all to such an approach. It neither suggests nor discloses objects or interactive application. Indeed, as a Teletext-based system it, in fact, teaches away from such an approach. And, the Examiner's mistaken attempt to rely on his obtuse objection to records as interactive applications are of no relevance at all, both because in accordance with Applicants' teaching, the records are objects which generate interactive applications as explained in the referenced specification portions, and because, the Examiner's himself withdrew his prior objection to the reference to records as interactive applications in the Advisory Action as also noted above.

Applicants' Claim 6 is not anticipated by the cited reference. The Examiner rejection of Claim 5 under §102(b) is in error and must be reversed. *Richardson Id.*

Continuing, Applicant's Claim 7 expressly recites:

7. The method of claim 6 wherein providing locator keywords indexed to respective record identifiers includes establishing the identifiers as object identifications.

As described above and in Applicants Appeal Brief, the cited reference neither suggests nor discloses:

- establishing respective record identifiers as object identifications.

Applicants' Claim 7 is not anticipated by the cited reference. The Examiner rejection of Claim 7 under §102(b) is in error and must be reversed. *Richardson Id.*

As to Applicants' Claim 8, it expressly recites:

8. The method of claim 6 wherein one of the multiple search procedures for entering the character sequence at the reception system includes entering the character sequence as a description of a desired application.

As described above and in Applicants Appeal Brief, the cited reference neither suggests nor discloses

- one of the multiple search procedures for entering the character sequence including entering the character sequence as a description of a desired application.

Applicants' Claim 8 is not anticipated by the cited reference. The Examiner rejection of Claim 7 under §102(b) is in error and must be reversed. *Richardson Id.*

Applicants' Claim 9 expressly recites:

9. The method of claim 6 wherein one of the multiple search procedures for entering the character sequence includes entering the character sequence as a selection of the desired application from an alphabetical listing of applications.

As described above and in Applicants Appeal Brief, the cited reference neither suggests nor discloses:

- one of the multiple search procedures for entering the character sequence being entering the character sequence as a selection of the desired application from an alphabetical listing of applications.

Applicants' Claim 9 is not anticipated by the cited reference. The Examiner rejection of Claim 9 under §102(b) is in error and must be reversed. *Richardson Id.*

Yet further, Applicants' Claim 10 expressly recites

10. The method of claim 6 wherein one of the multiple search procedures for entering the character sequence includes entering the character sequence as a selection of

the desired application from a subject-category listing of applications.

As described above and in Applicants Appeal Brief, the cited reference neither suggests nor discloses

- one of the multiple search procedures for entering the character sequence being entering the character sequence as a selection of the desired application from a subject-category listing of applications.

Applicants' Claim 10 is not anticipated by the cited reference. The Examiner rejection of Claim 10 under §102(b) is in error and must be reversed. *Richardson Id.*

With regard to Applicants Claims 11-15, these claims recites express limitations at least comparable to those recited in Claims 1-10. Accordingly, these claims would also be distinguished from the Cichelli et al. teaching on comparable grounds as described above and in Applicants Appeal Brief. Accordingly, Applicants' Claim 11-15 also are not anticipated by the cited reference. The Examiner rejections of Claims 11-15 under §102(b) are in error and must be reversed. *Richardson Id.*

IV. Summary

As noted above, in response to Applicants' Appeal Brief, the Examiner has submitted an Answer in which he has declined to address the points of law and presentations of fact submitted by Applicants. Rather than attempt to rebut the arguments advanced by Applicants which demonstrate the impropriety of the final rejection and which support patentability of the pending claims, the Examiner's in his Answer has merely restated the final rejection and offered scant and incomplete reference to minimal portions of the Applicants' Appeal Brief. Accordingly, the Examiner must be considered to have conceded the Applicants' arguments which he has declined to address. However, in the minimal response the Examiner has offered, he has raised a number new points of argument which Applicants have replied to above.

Accordingly, as demonstrated above and in Applicants' Appeal Brief, Applicants' inventive method as claimed has been neither suggested nor disclosed by Cichelli et al. Indeed, Cichelli et al., by its different technological approach and inherent limitations, in fact teaches away from Applicants' invention.

Applicants' invention is directed to a method for reducing search and access time in a large database of the type intended to support interactive services. Additionally, it features steps for simplifying the search process by providing users alternative strategies for entering queries which do not degrade search and retrieval performance.

Applicants do this by condensing the search process with pre-created subset searches of the database which can be accessed quickly and without need to review all the records of the database. As described, Applicants do this by creating tables of keywords indexed to identifications for the data records necessary to support the applications. Further, Applicants simplify the search process by coding the subset searches so they can be readily identified with multiple, different search strategies such as direct name entry, indexing, and subject categories, among others.

Cichelli et al. on the other hand, neither do, nor suggest any of these things. The Cichelli et al. teaching is directed to small databases in a non-interactive system. It concerns Teletext technology and sequential databases which are the direct opposites of the interactive, Videotext, approach of Applicants. Moreover, and most importantly, Cichelli et al. give no consideration at all to attempting to reduce record search and retrieval time. Their search and retrieval procedures concern only direct recourse to the main database. Indeed, by its inherent limitations and initial design, Cichelli et al. type systems are not concerned with the problems faced by Applicants. The Cichelli et al. database must be kept small to facilitate reasonable access time in view of the need to have the database records circulate. And, by virtue of its restricted database size, Cichelli et al. can and do undertake primary search of the records that make up their system. There is no suggestion whatsoever, for doing any preliminary searching against subsets of the databases in the Cichelli et al. teaching. Cichelli et al. present their entire database in an elaborate system of menu, sub-menu, relational and data screens which it requires the user to navigate through and make choices from in order

to identify the records desired. And as such, Cichelli et al. teaches nothing more than a conventional, menu-driven, although, cleverly laid out search procedure to access its records.

Cichelli et al. fail to disclose fundamental elements of Applicants' invention. Cichelli et al. do not suggest or disclose record locators, for example, keywords, indexed to identifiers for respective records, the locators collected in groups as predetermined subset searches of the database, and those groups then separately coded so the groups can be searched instead of the main database to expedite record location. And, Cichelli et al. fail to suggest or disclose arranging such a retrieval method so that multiple, independent search strategies to simply use can be translated into a single common record-identification process. *Richardson v. Suzuki Motor Co. Ltd.*, 869 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989);

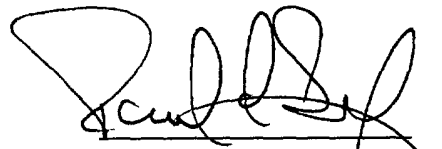
For the reasons noted here and above, Cichelli et al. neither suggests nor discloses Applicants' invention as claimed. Accordingly, the Examiner rejection of Applicants' claims as anticipated under §102(b) in view of Cichelli et al. must be reversed. *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986), *cert. denied*, 479 U.S. 1034 (1987); *Elmer v. ICC Fabricating Inc.*, 36 USPQ2d 1417, 1419-1420 (Fed. Cir. 1995).

Still further, neither is Applicants' invention as claimed indefinite when read in light of the specification by one skilled in the art. *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 806 F.2d 1565, 1 USPQ2d 1081, (Fed. Cir. 1986); *Shatterproof Glass Corp. v. Libby-Owens Ford Co.*, 758 F.2d 613, 225 USPQ 634, (Fed. Cir. 1985); *Miles Laboratories Inc. v. Shandon Inc.*, 997 F.2d 870, 27 USPQ2d 1123, (Fed. Cir. 1993). As noted each of the elements of Applicants' claims are described in detail in their specification and one skilled in the art is able to learn the scope of Applicants' invention upon a reading of those claims read in light of the specification. And indeed, this is apparent for the Examiners' ability to search the art and comprehend the invention. The Examiner's rejections of indefiniteness are without foundation and must be reversed.

Accordingly, in view of arguments presented in their Appeal Brief, and this Reply Brief which demonstrate the impropriety of the final rejection and the patentability of their invention, and the absence of justification for the final rejection in the Examiner's Answer, Applicants request that the Board Of Patent Appeals and Interferences order the final rejection of January 19th 1995 be withdrawn; that Applicants be permitted to amend their claims 1-15 as proposed; and that their claims be allowed and their application passed to issue.

Dated: April 29, 1996,

Respectfully submitted,

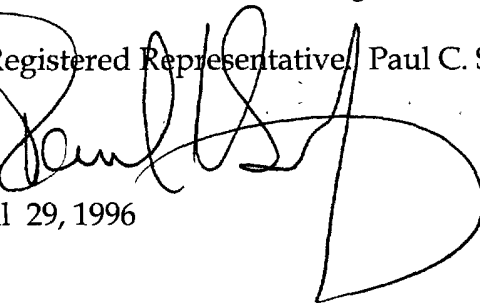


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I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231, on April 29, 1996

Name of Registered Representative: Paul C. Scifo, Esq.

Signature:



Date: April 29, 1996